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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,643	03/20/2002	Christine Millard	P 0291078	7429

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EXAMINER

POWERS, FIONA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 03/20/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,643

Applicant(s)

MILLARD ET AL.

Examiner

Fiona T. Powers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 to 6 is/are rejected.
- 7) ☒ Claim(s) 2 and 7 to 27 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Receipt is acknowledged of the preliminary amendment and disclosure statement filed March 20, 2002, which have been entered in the file.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 refers to "the process" but does not describe the process that is being referred to.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by British Patent 1359171, cited by applicants or Segal (US 4659807), cited.

The references disclose the claimed compositions wherein the solvent is water which comprise the compound of the formula

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(1) wherein R^1 is ethyl, R^2 is methyl, Z is hydrogen, one of X and Y is SO_3M and one of m and n is 1 and the other is 0 (GB 1359171) or wherein R^1 is carboxyethyl, R^2 is methyl, Z is $CONH_2$ and one of X and Y is β -sulfatoethylsulfonyl, and one of m and n is 1 and the other is 0 (Segal). Note Example 5 on page 12 of GB 1359171 and Example 3 in column 11 of Segal.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 3 to 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over British Patent 1359171 or Segal (US 4659807).

Determination of the scope and content of the prior art (MPEP §2141.01)

British Patent 1359171 discloses pyridoneazo dyestuffs which contain an acid substituent which are useful for the dyeing of nitrogen-containing fibers such as wool. The compound disclosed by the reference is of instant formula (1) wherein R^1 is ethyl, R^2 is methyl, Z is hydrogen, one of X and Y is SO_3M and

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one of m and n is 1 and the other is 0. Note Example 5 on page 12.

Segal discloses water-soluble pyridone monoazo compounds which are suitable as fiber reactive dyestuffs for hydroxy- and/or carboxamido-containing materials such as cotton. The compound disclosed by the reference is of instant formula (1) wherein R^1 is carboxyethyl, R^2 is methyl, Z is CONH_2 and one of X and Y is β -sulfatoethylsulfonyl, and one of m and n is 1 and the other is 0. Note Examples 3 and 20.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The claimed compounds which are homologs or close structural analogs of the compounds disclosed by the reference would have been rendered obvious. For example, compounds similar to Example 3 of GB 1359171 but where the group which corresponds to R^1 is methyl or propyl instead of ethyl or where the group which corresponds to R^2 of the present invention is ethyl instead of methyl would be rendered obvious. Additionally, compounds similar to Examples 3 and 20 of Segal but where H replaces CONH_2 or vice versa at the 3-position of the pyridone radical or where the group bonded to the pyridone nitrogen is carboxymethyl or sulfomethyl instead of carboxyethyl or sulfoethyl would have been rendered obvious. One of ordinary skill in the art would

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have been motivated to make the claimed compounds with the expectation that additional compounds useful for would be obtained.

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2413)

The interchangeability of the substituent mentioned above is taught by the references. Note formula (I) and the definition of R and R¹ on page 1 of GB 1359171 and formula (1) and the definitions of R and B in columns 1 to 2 of Segal.

One of ordinary skill in the art would have been motivated to make the claimed compounds with the expectation that additional compounds useful as dyestuffs would be obtained. The claimed compounds and compositions would have been rendered obvious by the teachings of the reference in the absence of any unobvious or unexpected property.

Claims 2 and 7 to 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The references made of record and not relied upon show the state of the art.

WO 99/43754 discloses pyridoneazo compounds which are useful in the preparation of inks. The compound of Example 1

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differs from the claimed compound in the substituent which corresponds to Z of the present invention. In the reference Z is a pyridinium radical but the optional substituent Z as defined in the instant specification does not include pyridinium radicals.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 703-308-4535. The examiner can normally be reached on Monday - Friday 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 703-308-4537. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Fiona T. Powers

Fiona T. Powers
Primary Examiner
Art Unit 1626

ftp
March 17, 2003